

ADMINISTRATIVE PANEL DECISION

Caffè Borbone S.r.l. v. Salvatore Zimotti, effetto GmbH
Case No. D2022-4410

1. The Parties

The Complainant is Caffè Borbone S.r.l., Italy, represented by Società Italiana Brevetti, Italy.

The Respondent is Salvatore Zimotti, effetto GmbH, Germany.

2. The Domain Name and Registrar

The disputed domain name <borbone.coffee> is registered with PSI-USA, Inc. dba Domain Robot (the “Registrar”).

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the “Center”) on November 18, 2022. On the same day, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On November 21, 2022, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent and contact information in the Complaint.

The Center sent an email communication to the Complainant also on November 21, 2022 providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on November 25, 2022.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the “Policy” or “UDRP”), the Rules for Uniform Domain Name Dispute Resolution Policy (the “Rules”), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the “Supplemental Rules”).

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on November 30, 2022. In accordance with the Rules, paragraph 5, the due date for Response was December 20, 2022. The Respondent did not submit any response. Accordingly, the Center notified the Respondent’s default on December 23, 2022.

The Center appointed Marilena Comanescu as the sole panelist in this matter on January 3, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

The Complainant, founded in 1997 in Naples, is a leading Italian company in the coffee industry. The Complainant is one of the Italian market leaders, producing approximately 96 tons of processed coffee daily in its Italian factories that are distributed all over the world. In 2020, the Complainant won the Business Excellence Award sponsored by the Italian Stock Exchange, and the Complainant has been acknowledged as one of the primary Italian players in the portioned coffee sector (compatible capsules and pods).

The Complainant owns numerous trademarks for BORBONE and CAFFÈ BORBONE in several jurisdictions including in the European Union, such as the following:

- the European Union stylized trademark BORBONE registration No. 015670532 filed on July 18, 2016, and registered on November 23, 2016, for goods and services in International Classes 7, 11, 21, 30, 35, 37, 40, and 43; and
- the European Union figurative trademark CAFFÈ BORBONE registration No. 015670541 filed on July 18, 2016, and registered on November 23, 2016, for goods and services in International Classes 7, 11, 21, 30, 35, 37, 40, and 43.

The Complainant owns numerous domain names related to its trademarks BORBONE and CAFFÈ BORBONE, its main website is available at “www.caffeborbone.com”.

The disputed domain name <borbone.coffee> was registered on May 29, 2019, and at the time of filing the Complaint it resolved to an inactive website.

According to the Amended Complaint and based on public online information, the Respondent Salvatore Zimotti is active in the same business as the Complainant, namely in the production of coffee and coffee related goods, and holds an e-commerce website promoting coffee products from various providers, including CAFFÈ BORBONE branded goods.

5. Parties' Contentions

A. Complainant

The Complainant contends that the disputed domain name reproduces entirely its trademarks BORBONE and CAFFÈ BORBONE, that the Respondent has no rights or legitimate interests in the disputed domain name, and that the Respondent registered and is using the disputed domain name in bad faith.

The Complainant requests the transfer of the disputed domain name to it.

B. Respondent

The Respondent did not reply to the Complainant's contentions.

6. Discussion and Findings

In view of the absence of a Response, the discussion and findings will be based upon the contentions in the Complaint and any reasonable position that can be attributable to the Respondent. Under paragraph 4(a) of

the Policy, a complainant can only succeed in an administrative proceeding under the Policy if the following circumstances are met:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights;
- (ii) the Respondent has no rights or legitimate interests in the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the concurrence of the above circumstances.

A. Identical or Confusingly Similar

The Panel finds that the Complainant holds rights in the BORBONE and CAFFÈ BORBONE trademarks.

The disputed domain name <borbone.coffee> incorporates the Complainant's trademark BORBONE in its entirety, with no additional terms, making the disputed domain name identical to the Complainant's trademark BORBONE. It is well established in decisions under the UDRP that the generic Top-Level Domain ("gTLD") (e.g., ".casino", ".coffee", ".com", ".tv") may typically be disregarded for the purposes of consideration of confusing similarity between a trademark and a domain name.

Further, when considering the disputed domain name in its totality with the gTLD extension, it reproduces the Complainant's trademark CAFFÈ BORBONE reversed and with a minor alteration, the letter "a" replaced by an "o". However, such alterations do not prevent a finding of confusing similarity between the Complainant's trademark and the disputed domain name. UDRP panels have recognized that where the applicable gTLD and the second-level portion of the domain name in combination reflect the relevant trademark, panels may consider the domain name in its entirety for purposes of assessing confusing similarity. See section 1.11.3 of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)").

Given the above, the Panel finds that the disputed domain name is identical to the Complainant's trademark BORBONE, and confusingly similar to the trademark CAFFÈ BORBONE, pursuant to the Policy, paragraph 4(a)(i).

B. Rights or Legitimate Interests

The Complainant asserts that the Respondent does not hold any trademark rights, license or authorization whatsoever to use the marks BORBONE / CAFFÈ BORBONE, that the Respondent is not commonly known by the disputed domain name, and that the Respondent has not used the disputed domain name in connection with a legitimate noncommercial or fair use or a *bona fide* offering of goods and services.

Under the Policy, "where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name. If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element". See section 2.1 of the [WIPO Overview 3.0](#).

The Respondent has not replied to the Complainant's contentions to advance a claim to any rights or legitimate interests in the disputed domain name.

There is nothing in the record suggesting that the Respondent has ever been commonly known by the disputed domain name or that the Respondent made a *bona fide* offering of goods or services or a legitimate noncommercial use under the disputed domain name. In fact the disputed domain name is kept inactive and this does not amount to a *bona fide* or legitimate use.

In addition, and without prejudice to the above, UDRP panels have found that domain names identical or highly similar to a complainant's trademark carry a high risk of implied affiliation. See section 2.5.1 of the [WIPO Overview 3.0](#).

Consequently, the Panel finds that the Respondent has no rights or legitimate interests in the disputed domain name, pursuant to the Policy, paragraph 4(a)(ii).

C. Registered and Used in Bad Faith

The Complainant holds trademark rights for BORBONE and CAFFÈ BORBONE since at least 2000 and its trademark is distinctive in relation to the goods and services claimed.

The disputed domain name was created in 2019, and incorporates the Complainant's marks and is very similar to the Complainant's corresponding domain name.

From the above, the Panel finds that the disputed domain name was registered in bad faith, with knowledge of the Complainant, its business, and particularly targeting its BORBONE / CAFFÈ BORBONE trademarks.

According to the case file documents before it, the Panel finds no evidence of actual use of the disputed domain name. From the inception of the UDRP, panels have found that the non-use of a domain name (including a blank or "coming soon" or other similar inactive page) would not prevent a finding of bad faith under the doctrine of passive holding. The Panel must examine all the circumstances of the case to determine whether the Respondent is acting in bad faith. Examples of what may be relevant circumstances found to be indicative of bad faith include the degree of distinctiveness or reputation of the complainant's mark and the failure of the respondent to submit a response or to provide any evidence of actual or contemplated good faith use. See section 3.3 of the [WIPO Overview 3.0](#). As previously mentioned, the disputed domain name incorporates the Complainant's distinctive trademark BORBONE and is very similar to the Complainant's domain name, and the Respondent failed to participate in this proceeding.

Further, the Respondent seems to be involved in a similar business, holding a commercial website where it promotes coffee goods, including the Complainant's branded goods.

Paragraph 4(b)(iii) of the Policy provides a circumstance of bad faith registration and use when the respondent has registered the domain name primarily for the purpose of disrupting the business of a competitor. Noting that the scenarios enumerated in UDRP paragraph 4(b) are non-exhaustive, UDRP panels have applied the notion of "competitor" beyond the concept of an ordinary commercial or business competitor to also include the concept of person "who acts in opposition to another" for some means of commercial gain, direct or otherwise. See section 3.1.3 of the [WIPO Overview 3.0](#). In the present case, the Respondent is keeping inactive the disputed domain name, identical to the Complainant's trademark, and according to the evidence provided by the Complainant, is offering for sale the Complainant's goods and also competing goods, on a website that appears to be related to the Respondent.

For all the above reasons, the Panel finds that the Respondent registered and is using the disputed domain name in bad faith, pursuant to the Policy, paragraph 4(a)(iii).

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <borbone.coffee> be transferred to the Complainant.

/Marilena Comanescu/

Marilena Comanescu

Sole Panelist

Date: January 12, 2023